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Sage Therapeutics, Inc v Registrar of Patents

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HIGH COURT (KUALA LUMPUR) — ORIGINATING SUMMONS NO WA-24IP-2–01 OF 2024
AZLAN SULAIMAN JC
7 MAY 2024

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Intellectual Property Law — Patent — Application for — Plaintiff's patent application refused and request to reinstate application and extend response time to substantive examination adverse report dismissed by defendant — Whether defendant erred in applying amended regulations for extension of time — Patents Act 1983 ss 30 & 82 — Patents Regulations 1986 reg 53

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The plaintiff filed an application to patent an invention with the Registrar of Patents ('registrar'), Intellectual Property Corporation of Malaysia ('MyIPO') ie the defendant ('the patent application'). The plaintiff then filed voluntary amendments to the claims in the patent application and, pursuant to reg 27(1)(A) of the Patents Regulations 1986 ('the Regulations'), requested for a substantive examination of the patent application. By a notice dated 30 March 2022 ('the registrar's notice'), the defendant sent to the plaintiff a substantive examination adverse report which stated that the patent application did not comply with the substantive requirements under s 30(1) of the Patents Act 1983 ('Act'). The defendant further invited the plaintiff to respond to the substantive examination adverse report within three months ie on or before 30 June 2022. However, the plaintiff did not file any response as it had evidently overlooked it. The plaintiff subsequently on 16 March 2023 applied to reinstate the patent application and for an extension of time to respond to the substantive examination adverse report ('reinstatement/EOT application'). On 6 June 2023, the defendant issued to the plaintiff a notice of refusal of the patent application under s 30(3) of the Act. Pursuant to s 81 of the Act, the plaintiff requested for an oral hearing to be held with regard to the notice of refusal. During the oral hearing, the plaintiff contended that: (a) the substantive examination adverse report should not have been issued in the first place as the patent application complied with the provisions and requirements of the Act; and (b) the defendant erred in law in issuing the notice of refusal and thereby rejecting the reinstatement/EOT application. The defendant issued its decision maintaining the notice of refusal and the dismissal of the reinstatement/EOT application on the basis that under reg 53(2) of the Regulations (as amended by the Patents (Amendment) Regulations 2022), the defendant's discretionary power to grant an extension of time was limited to six months only; and the human error in the plaintiff's failure to timely respond to the substantive examination adverse report did not suffice. Hence, this

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originating summons by the plaintiff. The plaintiff claimed that the defendant erred in fact and/or in law in dismissing the patent application and refusing/dismissing the reinstatement/EOT application by construing and applying the amended reg 53(2) of the Regulations when it should have applied the unamended reg 53(2) of the Regulations.

Held:

(1) The applicable provisions were ss 30(3) and 30(4) of the Act. Section 30 of the Act was activated after the plaintiff submitted a request to the defendant for a substantive examination of its patent application. It was under s 30(3) of the Act and by the registrar's notice that the defendant gave the plaintiff three months from the mailing date to respond to the substantive examination adverse report. Under s 30(4) of the Act, the defendant was empowered to grant an extension of that three month prescribed period, but 'only once' (see paras 32, 34, 36 & 40).

(2) The extension of the prescribed period under s 30(4) of the Act was not the same as an extension of time under s 82 of the Act. Firstly, the words 'and no subsequent extension may be granted under the provisions of s 82' in s 30(4) of the Act meant that a distinction between them was expressly recognised. Secondly, s 82 of the Act, whether pre-amendment or post-amendment, included the words 'subject to section 30(4)'. These two provisions meant that, when it came to an extension of time for the opportunity to be given to an applicant to make observations on an examiner's report under s 30(3) of the Act, then the applicable provision was s 30(4) of the Act, and not s 82 of the Act. This position would also be consistent with the maxim *specialia generalibus derogant*, ie special words derogate from general ones. The specific provision under the Act to extend the prescribed period of time to enable an applicant to make observations on an examiner's report was s 30(4) of the Act, and that this provision took precedence over the general provision for an extension of time under s 82 of the Act, be it under the Act as amended or un-amended (see paras 41–45).

(3) The words 'a request under s 82 of the Act' in reg 53 of the Regulations, be it pre-amendment or post-amendment, necessarily meant that reg 53 of the Regulations was only invoked when s 82 of the Act was invoked. Regulation 53 of the Regulations would not apply when an extension of time application was made under s 30(4) of the Act. Therefore, the defendant had erred in law in invoking and applying s 82 of the Act and reg 53 of the Regulations altogether (see paras 53 & 55).

(4) There was no reason to disbelieve that the plaintiff had indeed inadvertently overlooked the substantive examination of the patent application. Where the failure to respond within the prescribed period given was not intentional but genuinely attributable to human error and

inadvertence, then in the absence of any appreciable harm or prejudice to anyone, the appropriate course was to allow that extension of time. There would be no prejudice at all to the defendant or MyIPO if originating summons was decided in the plaintiff's favour. The defendant's decision was set aside and the patent application was reinstated; and the time for the plaintiff to make its observations under s 30(3) of the Act on the substantive examination adverse report was extended to 7 June 2024 without any further extension (see paras 59, 63, 66 & 69).

[Bahasa Malaysia summary

Plaintif telah memfailkan permohonan untuk mempatenkan satu ciptaan dengan Pendaftar Paten ('pendaftar'), Perbadanan Harta Intelek Malaysia ('MyIPO') iaitu defendan ('permohonan paten'). Plaintif kemudiannya memfailkan pindaan sukarela kepada tuntutan dalam permohonan paten dan, menurut peraturan 27(1)(A) Peraturan-Peraturan Paten 1986 ('Peraturan'), memohon untuk pemeriksaan substantif permohonan paten tersebut. Melalui notis bertarikh 30 Mac 2022 ('notis pendaftar'), defendan menghantar kepada plaintif laporan bertentangan pemeriksaan substantif yang menyatakan bahawa permohonan paten tersebut tidak mematuhi keperluan substantif di bawah s 30(1) Akta Paten 1983 ('Akta'). Defendan selanjutnya menjemput plaintif untuk menjawab laporan bertentangan pemeriksaan substantif dalam tempoh tiga bulan iaitu pada atau sebelum 30 Jun 2022. Walau bagaimanapun, plaintif tidak memfailkan apa-apa jawapan kerana ia ternyata terlepas pandang. Plaintif kemudiannya pada 16 Mac 2023 memohon untuk mengembalikan semula permohonan paten dan untuk melanjutkan masa untuk membalas laporan bertentangan pemeriksaan substantif ('permohonan pengembalian/EOT'). Pada 6 Jun 2023, defendan mengeluarkan kepada plaintif notis penolakan permohonan paten di bawah s 30(3) Akta. Berdasarkan s 81 Akta, plaintif memohon untuk pendengaran lisan diadakan berhubung dengan notis penolakan tersebut. Semasa pendengaran lisan, plaintif berhujah bahawa: (a) laporan bertentangan pemeriksaan substantif tidak sepatutnya dikeluarkan sejak awal kerana permohonan paten tersebut mematuhi peruntukan dan keperluan Akta; dan (b) defendan terkhilaf dari segi undang-undang dalam mengeluarkan notis penolakan dan dengan itu menolak permohonan pengembalian/EOT. Defendan mengeluarkan keputusannya mengekalkan notis penolakan dan penolakan permohonan pengembalian/EOT atas dasar bahawa di bawah peraturan 53(2) Peraturan (seperti yang dipinda oleh Peraturan-Peraturan (Pindaan) Paten 2022), kuasa budi bicara defendan untuk memberikan pelanjutan masa adalah terhad kepada enam bulan sahaja; dan kesilapan manusia dalam kegagalan plaintif untuk membalas laporan bertentangan pemeriksaan substantif tepat pada masanya tidak mencukupi. Oleh itu, saman pemula ini oleh plaintif. Plaintif mendakwa bahawa defendan terkhilaf dari segi fakta dan/atau undang-undang dalam menolak permohonan paten dan enggan/menolak permohonan pengembalian/EOT dengan mentafsir dan menggunakan peraturan 53(2)

Peraturan yang dipinda apabila ia sepatutnya menggunakan peraturan 53(2) Peraturan yang tidak dipinda.

Diputuskan:

(1) Peruntukan yang terpakai adalah ss 30(3) dan 30(4) Akta. Seksyen 30 Akta telah diaktifkan selepas plaintif mengemukakan permohonan kepada defendan untuk pemeriksaan substantif permohonan patennya. Ianya adalah di bawah s 30(3) Akta dan melalui notis Pendaftar bahawa defendan memberikan plaintif tiga bulan dari tarikh surat untuk menjawab laporan bertentangan pemeriksaan substantif. Di bawah s 30(4) Akta, defendan diberi kuasa untuk memberikan pelanjutan tempoh yang ditetapkan selama tiga bulan itu, tetapi 'sekali sahaja' (lihat perenggan 32, 34, 36 & 40).

(2) Lanjutan tempoh yang ditetapkan di bawah s 30(4) Akta adalah tidak sama dengan lanjutan masa di bawah s 82 Akta. Pertama, perkataan 'dan tiada pelanjutan boleh dibenarkan selepas itu di bawah peruntukan seksyen 82' dalam s 30(4) Akta bermaksud bahawa perbezaan antara keduanya telah diiktiraf dengan jelas. Kedua, s 82 Akta, sama ada sebelum pindaan atau selepas pindaan, termasuk perkataan 'tertakluk kepada seksyen 30(4)'. Kedua-dua peruntukan ini bermaksud bahawa, apabila ianya berkaitan dengan pelanjutan masa untuk peluang diberikan kepada pemohon untuk membuat pemerhatian ke atas laporan pemeriksa di bawah s 30(3) Akta, maka peruntukan yang terpakai adalah s 30(4) Akta, dan bukan s 82 Akta. Kedudukan ini juga adalah konsisten dengan maxim *specialia generalibus derogant*, iaitu perkataan khusus mengenepikan perkataan umum. Peruntukan khusus di bawah Akta untuk melanjutkan tempoh yang ditetapkan untuk membolehkan pemohon membuat pemerhatian ke atas laporan pemeriksa adalah s 30(4) Akta, dan peruntukan ini mendahului peruntukan umum untuk pelanjutan masa di bawah s 82 Akta, sama ada di bawah Akta yang dipinda atau tidak dipinda (lihat perenggan 41–45).

(3) Perkataan 'Permohonan di bawah seksyen 82 Akta' dalam peraturan 53 Peraturan, sama ada sebelum pindaan atau selepas pindaan, semestinya bermaksud bahawa peraturan 53 Peraturan hanya digunakan apabila s 82 Akta digunakan. Peraturan 53 Peraturan tidak akan terpakai apabila permohonan pelanjutan masa dibuat di bawah s 30(4) Akta. Oleh itu, defendan telah terkhilaf dari segi undang-undang dalam menggunakan s 82 Akta dan peraturan 53 Peraturan secara keseluruhannya (lihat perenggan 53 & 55).

(4) Tiada sebab untuk tidak mempercayai bahawa plaintif sememangnya telah terlepas pandang pemeriksaan substantif permohonan paten. Di mana kegagalan untuk menjawab dalam tempoh yang ditetapkan diberikan adalah tidak disengajakan tetapi disebabkan oleh kesilapan

manusia dan ketidaksengajaan, maka tanpa sebarang kemudaratan atau prejudis yang ketara kepada sesiapa pun, tindakan yang sesuai adalah untuk membenarkan pelanjutan masa itu. Tidak akan ada sebarang prejudis kepada defendan atau MyIPO jika saman pemula diputuskan memihak kepada plaintif. Keputusan defendan diketepikan dan permohonan paten dikembalikan semula; dan masa untuk plaintif membuat pemerhatian di bawah s 30(3) Akta ke atas laporan bertentangan pemeriksaan substantif dilanjutkan sehingga 7 Jun 2024 tanpa sebarang pelanjutan lanjut (lihat perenggan 59, 63, 66 & 69).]

Legislation referred to

Patent Regulations 1986 regs 27(1)(A), 47, 53, 53(2)
Patents Act 1983 ss 14, 15, 17B, 17B(4A), 26B, 26B(1B), 27, 27(1A), 28, 28(6), 29A, 29A(6), (8), 30, 30(1), (2), (3), (4), 81, 82

Khoo Guan Huat (Joshua Teoh with him) (Skrine) for the applicant.
Hani Afiqah (Intellectual Property Corporation of Malaysia (MyIPO)) for the respondent.

Azlan Sulaiman JC:

INTRODUCTION

[1] This case involves an application by an applicant who is applying to register a patent for an extension of time to respond to an examiners report under s 30 of the Patents Act 1983 ('the Act'). In the course of the judgment I will also touch on some of the other provisions for extending time under the Act.

SALIENT BACKGROUND FACTS

[2] The salient background facts set out below are not in dispute.

[3] On 3 January 2018, the plaintiff, through its agent ('plaintiff's agent'), filed Malaysian Patent Application No PI 2018000013 in respect of an invention entitled 'Oxysterols and Methods of Use Thereof' ('patent application') with the Registrar of Patents, Intellectual Property Corp of Malaysia ('registrar') in the requisite Forms 2A, 22 and 17 and enclosing other relevant documents for, inter alia, the Malaysian national phase entry of the patent application.

[4] On 6 July 2020, the plaintiff filed voluntary amendments to the claims in the patent application and, pursuant to reg 27(1)(A) of the Patent Regulations, 1986 ('the Regulations'), requested for a substantive examination of the patent application ('substantive examination').

[5] In 2022, the Act was amended by the Patents (Amendment) Act 2022, and those amendments came into force on 16 March 2022. The Regulations was also amended by the Patents (Amendment) Regulations 2022, and those amendments came into force just days later on 18 March 2022.

[6] By a notice dated 30 March 2022 ('registrar's notice'), the registrar sent to the plaintiff a substantive examination adverse report on the patent application ('substantive examination adverse report'). The grounds stated in the substantive examination adverse report were that the patent application did not comply with the substantive requirements under s 30(1) of the Act. In short:

(a) the plaintiff's corresponding European Patent No EP3319611B1 for the same invention ('plaintiffs European patent') had been granted with claims which are narrower in scope than the claims in the plaintiff's patent application;

(b) the present claims in the plaintiff's patent application are prima facie not novel and/or inventive as required by ss 14 and 15 of the Act having regard to the cited prior art; and

(c) the claims should be amended.

[7] In the registrar's notice, the registrar further invited the plaintiff to respond to the substantive examination adverse report:

> You are invited to respond to this report. In accordance with Regulation 27C/27D/27E, a response should be filed at the above Office or Branch Offices within *THREE (3) MONTHS* from the date of mailing, otherwise this application may be refused under Section 30(3) of the Patents Act 1983.

The date of mailing mentioned here was 30 March 2022. Thus, according to the registrar's notice, the plaintiff's response to the substantive examination adverse report was to be filed on or before 30 June 2022.

[8] The plaintiff did not file any response to the substantive examination adverse report by 30 June 2022. Though the plaintiff did not deny receiving the substantive examination adverse report on or around the said mailing date, it had evidently overlooked it. This is because on 16 March 2023, around 8 1/2 months after that deadline in the registrar's notice had expired, the plaintiff applied to reinstate the patent application and for an extension of time to respond to the substantive examination adverse report ('reinstatement/EOT application'). Together with the reinstatement/EOT application, the plaintiff enclosed a statutory declaration by the patent's agent deposed to on 16 March 2023 ('statutory declaration') stating, inter alia, that the substantive examination adverse report had been discovered on 'a routine check of the

application by a staff member in March 2023', that it had been 'inadvertently overlooked' and that 'the mistake was caused by human error and was completely unintentional'.

[9] Further, annexed to the statutory declaration was a letter dated 6 July 2022 ('the 6 July 2022 letter) that the patent's agent had issued to the registrar enquiring about the plaintiff's request for the substantive examination. However, neither MyIPO nor the registrar had responded to it.

[10] On 6 June 2023, the defendant issued to the plaintiff a notice of refusal ('notice of refusal') of the patent application under s 30(3) of the Act, on the ground that:

> The records of this office indicate that no satisfactory response has been filed within the specified time in response to the substantive/modified examination adverse report under section 30(1)/30(2) dated 30 March 2022

[11] On 1 September 2023, pursuant to s 81 of the Act, the plaintiff requested for an oral hearing to be held with regard to the notice of refusal.

[12] On 22 September 2023, pursuant to s 81 of the Act and reg 47 of the Regulations, the registrar issued a notice of request for opportunity of being heard ('oral hearing notice') to the plaintiff scheduling an oral hearing on 22 November 2023 ('oral hearing').

[13] Prior to the oral hearing, the plaintiff confirmed the plaintiffs attendance at the oral hearing and further submitted an export report from Dr Khoo Teng Jin, a professor in the School of Pharmacy of University of Nottingham Malaysia together with its appendixes ('plaintiffs expert report'), to respond to the substantive examination adverse report.

[14] The oral hearing proceeded on 22 November 2023, at which the plaintiff essentially contended:

(a) that the substantive examination adverse report should not have been issued in the first place as the patent application complied with the provisions and requirements of the Act; and

(b) the registrar erred in law in issuing the notice of refusal and thereby rejecting the reinstatement/EOT application.

[15] On 20 December 2023, the registrar issued its decision maintaining the notice of refusal and the dismissal of the reinstatement and EOT application ('registrar's decision'). In its grounds of decision dated 20 December 2023

('registrar's grounds'), the registrar in effect stated that it had made the registrar's decision on the basis that:

(a) under reg 53(2) of the Regulations (as amended by the Patents (Amendment) Regulations 2022), the registrar's discretionary power to grant an extension of time is limited to six months only; and

(b) the human error in the plaintiff's failure to timely respond to the substantive examination adverse report did not suffice.

[16] By this originating summons ('plaintiff's appeal'), the plaintiff is appealing against the registrar's decision, and seeks the following orders/relief:

(a) that the patent application be accepted and allowed to proceed to grant;

(b) alternatively, that the plaintiff be allowed to reinstate the plaintiffs patent application and/or allowed an extension of time to respond to the objections raised in the substantive examination adverse report;

(c) that the costs of the plaintiff's appeal be paid by the registrar to the plaintiff; and

(d) such further or other orders as this honourable court deems fit and proper to grant.

[17] The plaintiffs grounds for the plaintiff's appeal may be summarised as follows:

(a) the registrar erred in fact and/or in law in dismissing the patent application and refusing/dismissing the reinstatement and EOT application by construing and applying reg 53(2) of the Regulations as amended by the Patents (Amendment) Regulations 2022 when it should have applied the unamended reg 53(2) pre-amendment; and

(b) the registrar erred in fact and/or in law in dismissing the patent application on the basis that the claims in it were neither novel nor inventive.

DISCOUNTING ALLOWING THE PATENT APPLICATION

[18] My decision and therefore this judgment will be confined to deciding whether the registrar erred in fact and/or in law in dismissing the patent application and the reinstatement and EOT application by applying reg 53(2) of the Regulations as amended by the Patents (Amendment) Regulations 2022, and if so, whether to allow the corresponding relief sought in the originating summons that the plaintiff be allowed to reinstate the patent application and/or allowed an extension of time to respond to the substantive examination adverse report.

[19] I will refrain from considering and deciding whether the patent application should be accepted and allowed to proceed to grant. This is because, given the extensive and detailed processes under the Act and Regulations for a patent to be approved and registered, all of which have yet to be undertaken, ordering that the patent application be accepted and allowed to proceed to grant at this stage through this originating summons would be premature and would have the effect of circumventing those statutory and regulated processes.

[20] Moreover, the registrar's decision was predominantly based on the failure of the plaintiff to respond within time to the substantive examination adverse report, and not on the merits or otherwise of the patent application or on the plaintiffs responses in the plaintiff's expert report to the substantive examination adverse report.

ANALYSIS AND DECISION

[21] In regard to the registrar's decision, the parties have clearly drawn their battle lines around whether the registrar ought to have applied s 82 of the Act and reg 53 pre-amendment or post-amendment. The plaintiff says that the registrar ought to have applied them pre-amendment, whilst the registrar's position is that it was compelled to have applied them post-amendment.

[22] For a better understanding of their respective positions, it would be prudent to those provisions out.

[23] Section 82 of the Act pre-amendment provided:

> Subject to subsection 1(A) of section 27, subsection (8) of section 29A and subsection (4) of section 30, where by this Act or any Regulations made thereunder a time is specified within which an act or thing is to be done, the Registrar may, unless otherwise expressly directed by the Court, extend the time either before or after its expiration upon payment of the prescribed fee.

[24] Regulation 53 of the Regulations pre-amendment provided:

> Request for extension of time
>
> A request under section 82 of the Act shall be made to the Registrar on Form 21 together with the payment of the prescribed fee.

[25] Thus, under s 82 of the Act and reg 53 of the Regulations before they were amended, no time limit or restraint was expressed for the registrar to extend the time for an act or thing is to be done under the Act. Nevertheless, the word 'may' in s 82 meant that it was still within the registrar's discretion to decide whether or not to extend the time.

[26] By s 60 of the Patents (Amendment) Act 2022 which came into force on 16 March 2022, s 82 of the Act was amended to now read as follows:

> (1) Subject to subsection 17B(4A), subsection 26B(1B), subsection 27(1A), subsection 28(6), subsection 29A(8) and subsection 30(4), where, by this Act or any Regulations made thereunder a time is specified within which an act or thing is to be done, the Registrar may, unless otherwise expressly directed by any Court, extend the time either before or after its expiration upon payment of the prescribed fee.
>
> (2) The request for extension of time after the expiration of a prescribed period of this Act or any Regulations made under this Act shall be made within the period as prescribed.

[27] By reg 60 of the Patents (Amendment) Regulations 2022 which came into force on 18 March 2022, reg 53 of the Regulations was amended to now read as follows:

> Request for extension of time
>
> (1) A request under section 82 of the Act shall be made to the Registrar in the form as determined by the Registrar together with the payment of the prescribed fee.
>
> (2) Notwithstanding anything contained in these Regulations, the request for extension of time after the expiration of a prescribed period under the Act or any Regulations under the Act shall be made not later than six months from the expiration of the prescribed period.

[28] Thus, by these amendments, any application for an extension of time under s 82 of the Act is to be made no later than six months from the expiration of the prescribed period in question.

[29] In the context of this case, in applying reg 53(2) of the Regulations (as amended), the registrar has taken the absolute position that the plaintiff ought to have filed the reinstatement and EOT application on or before 30 December 2022, ie six months from the expiry of the 30 June 2022 deadline imposed in the registrar's notice, and that it did not therefore have any power or discretion to entertain or allow the reinstatement and EOT application that the plaintiff had filed after that on 16 March 2023.

[30] The plaintiff takes the contrary position, namely that, because of s 69(1), (2) and (3) of the Patents (Amendment) Act 2022, the registrar should have applied reg 53 of the Regulations as it stood prior to the amendment, ie without any time limit.

[31] Sections 69(1), (2) and (3) of the Patents (Amendment) Act 2022 provide:

Saving and transitional provisions

(1) Any application or request made under the principal Act relating to a patent application or an application for a certificate for a utility innovation which is pending before the date of the coming into operation of this Act shall, on the date of the coming into operation of this Act, be dealt with in accordance with the provisions of the principal Act as if the principal Act had not been amended by this Act.

(2) Any application or request made under the principal Act relating to a patent or a certificate for a utility innovation which is pending before the date of coming into operation of this Act shall, on the date of coming into operation of this Act, be dealt with in accordance with the provisions of the principal Act as if the principal Act had not been amended by this Act

(3) Any action relating to a patent application or an application for a certificate for a utility innovation taken or commenced under the principal Act which is pending before the date of coming into operation of this Act shall, on the date of coming into operation of this Act, be continued in accordance with the provisions of the principal Act as if the principal Act had not been amended by this Act.

[32] With respect, I find that they are both wrong, as they have both overlooked the applicable provisions, which in my view are s 30(3) and 30(4) of the Act. For context, sub-s (1) to (3) of s 30 of the Act are first set out below:

(1) Where a request for substantive examination has been filed under subsection 29A(1), the Registrar shall refer the application to an Examiner who shall —

(a) determine whether the application complies with those requirements of this Act and the Regulations made under this Act which are designated by such Regulations as substantive requirements for the purposes of this Act; and

(b) report his determination to the Registrar.

(2) Where a request for a modified substantive examination has been filed under subsection 29A(2), the Registrar shall refer the application to an Examiner who shall —

(a) determine whether the application complies with those requirements of this Act and the Regulations made under this Act which are designated by such Regulations as modified substantive requirements for the purposes of this Act; and

(b) report his determination to the Registrar.

(3) If the Examiner reports, in accordance with subsection (1) or (2), that any of the requirements referred to in subsection (1) or (2), as the case may be, are not complied with, the Registrar shall give the applicant an opportunity to make observations on the report and to amend the application so as to comply with those requirements, within the prescribed period, and if the applicant fails to satisfy the Registrar that those requirements are complied with, or to amend the application so

as to comply with them, the Registrar may refuse the application.

[33] It is important to note that these provisions were not amended by the Patents (Amendment) Act 2022. Thus, they have remained constant and applicable throughout.

[34] Section 30 of the Act is activated after an applicant submits a request to the registrar for a substantive examination of its patent application, which the plaintiff here had done on 3 January 2018. Under s 30(1) of the Act, upon receipt of such request, the registrar is compelled to refer the patent application to an examiner. The examiner then examines the patent application to determine whether it complies with the Act and the Regulations, and then reports his/her determination to the registrar.

[35] From the substantive examination adverse report, it is clear that the examiner was of the view that the patent application did not comply with the Act and the Regulations, which then compelled the registrar to issue the registrar's notice to the plaintiff, under s 30(3) of the Act.

[36] It is under s 30(3) of the Act and by the registrar's notice that the registrar gave the plaintiff three months from the mailing date to respond to the substantive examination adverse report. That three months would have been 'the prescribed period' that s 30(3) of the Act refers to, which it says was for the opportunity to be given to the plaintiff as applicant to make observations on the substantive examination adverse report.

[37] It is also under s 30(3) of the Act that the registrar decided to refuse the patent application; the notice of refusal expressly says so.

[38] As the reference of the patent application to the examiner, the substantive examination adverse report, the registrar's notice and the notice of refusal all took place under the provisions of s 30 of the Act, then the logical first step was to examine whether s 30 of the Act also catered for an extension of time for the opportunity to be given to the plaintiff as applicant to make observations on the substantive examination adverse report. It did. Under s 30(4).

[39] Section 30(4) of the Act provides:

> The Registrar may grant an extension of the prescribed period referred to in subsection (3) but such extension may be granted only once and no subsequent extension may be granted under the provisions of section 82.

[40] Hence, under s 30(4) of the Act, the register is empowered to granted an

extension of that three month prescribed period, but 'only once'. Logically and understandably, the register would expectedly only grant such extension on the applicant's request, and not on its own accord. Crucially, s 30(4) of the Act does not prescribe any time period within which an application to extend the time is to be made, nor any limit on the duration of any extension of time granted. Time is left at large. Which to me is logical, given that the process of submission of a patent application and its approval or rejection can take years. That is takes years is not something to be frowned upon; given the 20 year monopoly that an inventor would enjoy over a patented invention, the patent application and its approval ought to be subject to stringent examination.

[41] I am further of the view that an extension of the prescribed period under s 30(4) of the Act is not the same as an extension of time under s 82 of the Act.

[42] Firstly, the words 'and no subsequent extension may be granted under the provisions of section 82' in s 30(4) of the Act mean that a distinction between them is expressly recognised.

[43] Secondly, s 82 of the Act, whether pre-amendment or post-amendment, includes the words 'subject to section 30(4)'.

[44] In my view, what these two provisions mean is that, when it comes to an extension of time for the opportunity to be given to an applicant to make observations on an examiner's report under s 30(3) of the Act, then the applicable provision is s 30(4) of the Act, and not s 82 of the Act. In other words, the first port of call to apply for an extension of time for the opportunity for an applicant to make observations on an examiner's report is s 30(4) of the Act, not s 82 of the Act.

[45] This position would also be consistent with the maxim *specialia generalibus derogant,* ie special words derogate from general ones. In other words, the specific provision under the Act to extend the prescribed period of time to enable an applicant to make observations on an examiner's report is s 30(4) of the Act, and that this provision takes precedence over the general provision for an extension of time under s 82 of the Act, be it under the Act as amended or un-amended.

[46] To support this position, I have tested it against the other provisions of the Act that the amended s 82 of the Act expressly mentions that it is 'subject to', namely ss 17B(4A), 26(B)(1B), 27(1A), 28(6), and s 29A(8).

[47] Section 17B of the Act is the provision for converting an application for a patent into an application for a certificate for a utility innovation, and vice

A versa. Section 17B(4) of the Act provides that a request for such conversion shall be filed with the Registrar within the prescribed period, and s 17(B)(4A) of the Act provides:

> Without prejudice to the power of the Registrar to allow conversion, the prescribed period referred to in subsection (4) shall not be extended under section 82.

B

[48] Section 26B of the Act is the provision for making a request to the registrar within the prescribed period to divide a divisional application for a patent into two or more applications. Section 26B(1B) of the Act provides:

C

> Without prejudice to the power of the Registrar to allow for divisional application, the prescribed period referred to in subsection (1) shall not be extended under section 82.

D **[49]** Section 27 of the Act is the provision for seeking a declaration claiming a right of priority of the patent applied for, pursuant to any international treaty or Convention, of one or more earlier national, regional or international applications filed in respect of the same invention, during the twelve months preceding the filing date of the application. Section 27(1A) of the Act provides:

E

> The period of twelve months mentioned in subsection (1) may not be extended under section 82.

[50] Section 28 of the Act is the provision prescribing the filing date of the application for a patent, and s 28(6) of the Act provides:

F

> The prescribed period referred to in subsections (2), (2A) and (4) shall not be extended by the Registrar under section 82.

G **[51]** Section 29A of the Act is the provision for requesting for a substantive examination of the application, including a modified substantive examination. Section 29(A)(6) provides for the registrar having the power, upon the applicant's request, to defer the filing of the request for a modified substantive examination, and s 29A(8) provides:

H

> Without prejudice to the power of the Registrar to grant a deferment, the period prescribed for the purposes of this section may not be extended under section 82.

[52] What is obvious from all of these other provisions of the Act cited in s 82 of the Act is that they are to be applied to those given scenarios for extensions of time, and an extension of time under s 82 of the Act has no application and cannot be invoked in any of those scenarios. *Specialia generalibus derogant.*

I

[53] Further, the words 'A request under s 82 of the Act' in reg 53 of the

Regulations, be it pre-amendment or post-amendment, necessarily means that reg 53 of the Regulations it is only invoked when s 82 of the Act is invoked. It follows that reg 53 of the Regulations would not apply when an extension of time application is made under s 30(4) of the Act.

[54] And, if reg 53 does not apply at all, then it matters not what reg 53 provided either pre-amendment or post-amendment.

[55] Therefore, I find that the registrar had erred in law in invoking and applying s 82 of the Act and reg 53 of the Regulations altogether.

[56] The registrar may contend that the plaintiff had itself submitted the reinstatement/EOT application under s 82 of the Act, but that is not quite correct; all it asked for in the reinstatement/EOT Application is that 'the registrar exercises its discretionary powers under s 81 to allow an extension of time to respond to the examination report and reinstatement of the application'.

[57] The registrar may further contend that the plaintiff had itself relied and submitted on s 82 of the Act and reg 53 of the Regulations. However, the plaintiff's request for the oral hearing denotes that it was the registrar that had first invoked those provisions.

[58] Furthermore, at the end of the day, all the plaintiff really wanted by the reinstatement/EOT application is that opportunity to make observations on the substantive examination adverse report. And the only reason why it had not done so within the three months that the registrar had prescribed in the registrar's notice was that the substantive examination adverse report had inadvertently been overlooked.

[59] I find no reason to disbelieve that the office of the plaintiff's agent had indeed inadvertently overlooked the substantive examination of the patent application, given that months after that on 6 July 2022 the patent's agent had issued a letter to the registrar enquiring about the plaintiff's request for the substantive examination. Nor has the registrar challenged or disputed the truthfulness of that explanation.

[60] I note, too, that the plaintiff's agent's letter dated 6 July 2022 following up with the registrar on the plaintiff's request for the substantive examination bears MyIPO's rubber stamp affixed on 6 July 2022, which proves that MyIPO had received it on that date. That was just short of a week after the three month deadline in the registrar's notice had expired. Neither MyIPO nor the registrar had responded to that letter, either timely or at all.

[61] I dare say that it is reasonable to assume that the registrar's response to the plaintiff's agent's letter dated 6 July 2022 would surely have been to point out that the registrar's notice and the substantive examination adverse report had already been issued the week before. Given the evidence of the plaintiff's conduct from the exhibited documents — particularly in discovering the substantive examination adverse report and then hastily submitting the reinstatement/EOT application days later in June 2023 — I dare say that it is further reasonable to assume that, had the registrar duly informed the plaintiff timeously of the registrar's notice and the substantive examination adverse report that had been issued, in all likelihood the plaintiff would have responded to the substantive examination adverse report promptly. That would in all likelihood have been within six months of the expiry of the three month period prescribed in the registrar's notice, and correspondingly in all likelihood would have been met within the favourable exercise of discretion by the registrar to accept it and consider it.

[62] I have not overlooked the fact that s 30(4) of the Act does say that the registrar 'may grant an extension of the prescribed period', which means it is ultimately up to the registrar. However, as the notice of refusal and the registrar's grounds make it clear that the registrar's decision was based solely on non-compliance with the specific time period prescribed by reg 53 of the Regulations which ultimately did not apply, then in the absence of any time period, I will assume that the registrar would not have any objections to extending time for the plaintiff to have made observations and responded to the substantive examination adverse report.

[63] I find that, in a situation like this here where the failure to respond within the prescribed period given is not intentional but genuinely attributable to human error and inadvertence, then in the absence of any appreciable harm or prejudice to anyone, the appropriate course is to allow that extension of time. After all, here there was evidence that the plaintiff had registered its patents in other jurisdictions that its intention was simply to expand that registration to our shores.

[64] Furthermore, s 30(3) of the Act states that 'the registrar shall give the applicant an opportunity to make observations on the report', and that the registrar may refuse the application if the applicant does not do so. In my view, these words suggest a consultative process between the applicant, the registrar and even the examiner, where strict adherence to time is not paramaount or the overriding consideration.

[65] Finally, in a scenario like this where the court takes the view that both sides have erroneously cited and applied the wrong provisions of the law, in my

view the judicious approach would be to evaluate the comparative prejudice to each of them.

[66] In my view, there would be no prejudice at all to the registrar or MyIPO if the court decides the originating summons in the plaintiff's favour. After all, what would next transpire is that the plaintiff would be afforded the opportunity to make observations on the substantive examination adverse report, and the provisions and processes for eventually allowing or refusing the patent application would kick in. They would simply have gone back in time to the situation they were in when the registrar's notice was first issued. The approval or rejection of the patent application would still be up in the air and, if the registrar eventually decides that the patent application still does not comply with the requirements of the Act and Regulations and/or the plaintiff adamantly sticks by its stand that it does, then the registrar is not estopped or prevented from refusing the patent application.

[67] Taking into account that s 30(3) of the Act expressly speaks of giving the applicant 'an opportunity to make observations on' the substantive examination adverse report, surely that opportunity should not be denied when the failure to do so within the three month prescribed period was neither intentional nor blatant, but precipitated by human/clerical error.

[68] Conversely, if the court decides the originating summons in the registrar's favour, then it would be back to the proverbial drawing board for the plaintiff who given its patent applications in other jurisdictions in all likelihood would re-submit afresh the patent application to the registrar.

CONCLUSION AND ORDERS

[69] Based on the foregoing, I therefore find in favour of the plaintiff that the registrar had erred in making the registrar's decision, and make the following orders on the originating summons:

(a) that the registrar's decision be set aside and Patent Application No PI 2018000013 dated 6 July 2016 be reinstated;

(b) that the time for the plaintiff to make its observations under s 30(3) of the Patents Act 1983 on the substantive examination adverse report dated 30 March 2022 be extended to 7 June 2024 without any further extension, failing which the registrar may refuse the Patent Application No PI 2018000013 dated 6 July 2016; and

(c) that there be no order as to costs.

[70] In my view, that one month period should be sufficient given that the plaintiff already has in hand the plaintiff's expert report.

Order accordingly.

Reported by Nabilah Syahida Abdullah Salleh